



Practitioner's Docket No. 281-329.02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

November 2, 2001

Ervin Goldfain, et al.

Filed: May 22, 2001

Ser. No.: 09/862,636

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Office of Petitions
Assistant Commissioner for Patents
Washington, DC 20231

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Tammy S. Senecal
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**PETITION TO SUBMIT NOTICE OF FOREIGN FILING AND RESCISSION OF
NONPUBLICATION REQUEST UNDER RULE 37 C.F.R. 1.213 (35 U.S.C.
122(b)(2)(B)).**

Sir:

1. Applicants filed a PCT application concurrently with the present application which claimed the priority of this U.S. application. This application and PCT/US01/16557 were both filed on May 22, 2001.

2. 35 U.S.C. § 122(b)(2)(B) provides that an applicant who *subsequently* files a foreign application that is "directed to the invention" disclosed in the U.S. application in which a request for nonpublication is made, must provide notice to the Director of the Publication Office of such foreign filing. The present application and PCT/US01/16557 were filed concurrently on May 22, 2001.

3. Applicants wish to avoid having the present application being considered abandoned by the USPTO based on the technicality that this notice of foreign filing is made more than 45 days after such filing. 35 U.S.C. § 122(b)(2)(B)(iii) provides: *A failure of the applicant to provide [notice of a subsequent foreign filing] within the prescribed time period shall result in the application being abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.*

4. Accordingly, applicants are concerned that when subjected to review before the courts, an International application filed on the same day as a U.S. application

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could possibly be argued to constitute a "subsequent filing" under 35 U.S.C. § 122(b)(2)(B). On the contingency that such an argument is set forth, applicants, in Paragraphs 5-9 below demonstrate that the delay of this notice was unintentional. Applicants also enclose a copy of a Request to Rescind Previous Request for Nonpublication, filed in the USPTO concurrently with this petition.

5. The new Publication Laws under 35 U.S.C. § 122 while lengthy and complex, are also subject to multiple interpretations. For example, there is no explanation of what is meant by the phrase "directed to the invention" as mentioned in paragraphs 1 and 2 above. The new Publication Rules under 37CFR § 1.213 are also complex and subject to multiple interpretations. Note § 1.213(a) which states "if the invention which is disclosed in the application has not been...the subject of an application filed in another country." Does that refer to *all* inventions disclosed in the application, even collateral supporting material inventions which were the subject of foreign-filed applications say 5 or 10 years in the past? The rules are also arguably at odds with the Laws in certain respects. For example, the Laws state that the Notice of Foreign Filing is to be made "to the Director [of Publication], while the Rules state that the Request is to be made to the "Office," which in the Rules refers to the Patent Office in General. Note therefore that under the Rules, the mere act of filing a PCT application in the U.S. Receiving Office (as in the PCT/US01/16557) could be considered sufficient notice of foreign filing to "the Office" under 37CFR 1.213(c). The Rules under 37CFR 1.213(b) requiring a "conspicuous" request, relate to a request for rescission, not to the notice requirements under 1.213(c). It is the failure of notice under 1.213(c), not a failure of recision under 1.213(b) which gives rise to possible abandonment of a U.S. application.

6. The newness, vagueness, and complexity of the Publication Laws and Rules has rendered it difficult for law firms specializing in patent application prosecution to develop a clear, formalized and fool-proof set of office procedures for assuring compliance with the Publication Law and Rules. The law firm of Applicants' attorneys, Wall Marjama and Bilinski, LLP (hereinafter WMB) developed tentative procedures for assuring compliance with the Publication Laws and Rules in November, 2000, but decided that they would revisit these procedures and develop them more fully at a later date when more information became available from the USPTO suggesting appropriate procedures for assuring compliance with the Publication Laws and Rules. WMB subscribes to a patent docketing

system provider a commercial vendor, Computer Packages, Inc. (CPI). However, CPI's patent docketing system will not be revised to reflect the new Publication Laws and Rules until 2002. In November 2000, WMB informally determined that it would review its filed applications for compliance with the Publication Laws and Rules at approximately the 11th month anniversary of the effective date of 35 U.S.C. § 122, in October 2001. In other words, WMB developed a time driven "flag" for checking for compliance with the Publication Laws and Rules, whereas, in retrospect an event-driven "flag," driven by the event of international filing may have been more appropriate. The date for compliance review (October 2001) was selected because foreign applications filed by WMB are almost always filed between the 11th and 12th month anniversaries from the U.S. filing date. Thus, it was believed that no foreign application giving rise to operation of 35 U.S.C. § 122(b)(B)(iii) would be filed until November 2001, at the earliest. Because of the harsh result under 37 C.F.R. § 1.213(1) (opportunity for Nonpublication Request Lost if not made upon filing) and because of WMB's original interpretation of the Publication Laws and Rules (made without the benefit of additional information regarding possible interpretations and operations of the Laws and Rules which have since become available), WMB also instituted a procedure wherein Nonpublication Requests would ordinarily be made by default on filing.

7. Because of unusual circumstances, PCT US01/16557 was filed claiming priority of the present application, filed on the same day as PCT US01/16557. Application Serial No. 09/862,636 and PCT US01/16557 were both filed May 22, 2001.

8. When finalizing the paperwork associated with PCT US 01/16557, applicants' attorney decided to claim priority of U.S. Serial No. 09/862,636 to better set forth the lineage of PCT US 01/16557 for persons reviewing the file history of PCT US 01/16557, even though such claim provided no discernable advantage in terms of legal rights obtained (given that the applications were being filed on the same day). Applicants filing of a Request for Nonpublication in the present application was made pursuant the default Nonpublication Request filing procedure described herein, Paragraph 6.

9. Because of the unusually short duration between the time of U.S. and foreign filing (they were filed on the same day), the present application escaped WMB's time driven review process, to be triggered in October 2001, described in paragraph 6, in time to

submit the Notice of Foreign Filing within 45 days of the foreign filing.

10. For the reasons outlined, the delay of this notice of foreign filing was unintentional and was in no way the result of an effort to hide or obscure applicants' foreign filing activities from the observation of the USPTO.

11. Applicants therefore petition for submission of the notification of foreign filing, and a decision by the Board of Petitions stating that the present application is still pending before the USPTO and is not considered abandoned.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-0289.

Respectfully submitted,

WALL MARJAMA & BILINSKI, LLP

Date: November 2, 2001

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